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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,462	08/01/2003	Carl K. Knopp	018158-004990US	3822

20350 7590 12/02/2005

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EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
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3735

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/632,462

Applicant(s)

KNOPP

Examiner

david shay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 12, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The abstract of the disclosure is objected to because the abstract does not give the gist of the claimed invention. Correction is required. See MPEP § 608.01(b). This objection finds basis in Rule 37 CFR 1.72, as clearly set forth in MPEP § 608.01(b).

With regard to the rejection of claim 3, the examiner notes that claim 3 (and the other claims as well) are still devoid of the term “means for” and as such do not satisfy the first prong of the test for means plus function language. Thus such language in claim 3 (and the other claims) is merely regarded as intended use language (see MPEP § 2181). While this merely renders the other claims as much broader than they otherwise would be, claim 3, devoid of any structure and merely appearing to be a statement of intended use, does not appear to limit the claim from which it depends. Similarly with regard to the recitations in the claims of the generation of images and signals and the various intended uses thereof, these, absent conformance with the form set forth in 35 USC 112, sixth paragraph and MPEP § 2181, are merely statements of intended use or intended result and do not further define the structures or steps with which they are associated. As such, these intended uses and intended results cannot be relied upon to distinguish over the prior art as applied in the ensuing rejections.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, the claim merely recites the specific location where certain intended uses of the structure recited in the independent claim are to be carried out, however, since the recitations

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in the claim do not satisfy the first prong of the three prong test for a means plus function recitation set forth in MPEP 2181, these recitations are not read as functions, but merely intended use and therefore, limitations on these uses do not further limit the structure recited in the independent claim.

Claims 1-5, 7, 9, 11, and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bille et al. ('340).

Bille et al. ('340) instructs the artisan of ordinary skill to use the system set forth therein with the system described in Bille et al. ('718).

Claims 1-5, 7- 9, 11-13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pflibsen et al

Claims 1-7, 9, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bille et al. ('340) in combination with Bille et al. ('718). Bille et al. ('340) teaches an eye tracking laser surgical device which will track the eye in X-, Y-, and Z-directions, including a processor, a detector, a laser, a display, and an imaging system. Bille et al. ('718) teaches a laser redirecting system to keep the surgical laser trained on the eye as the eye moves, including steering means for the X- and Y- directions and a focusing means. It would have been obvious to the artisan of ordinary skill to employ the laser steering device as taught by Bille et al. ('718) in the device of Bille et al. ('340), since Bille et al. ('340) specifically say to do so, and to employ an analog processor rather than a computer, since analog processors respond more quickly than digital processors, official notice of which is hereby taken, thus producing a device such as claimed.

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Claims 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bille et al. ('340) in combination with Bille et al. ('718) as applied to claims 1 and 11, and further in combination with Kohayakawa. Kohayakawa teaches that the laser must be stopped and the eye realigned before the surgery is resumed. It would have been obvious to the artisan of ordinary skill to employ the laser shut down device and method suggested by Kohayakawa in the combined device and method of Bille et al. ('340) and Bille et al. ('718), since this is required for the surgery to be successful in the case that the eye moves out of range, thus producing a device such as claimed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 43, 44, and 55-58 of U.S. Patent No. 6,299,307.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, the application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while application claims only requires elements A, B, and C.

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Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-80 of U.S. Patent No. 6,099,522. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, the application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while application claims only requires elements A, B, and C. Thus it is apparent that the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 5,865,832. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, the application claims are not patentably distinct from the patent claims. Here, the patent claims require elements A, B, C, and D while application claims only requires elements A, B, and C. Thus it is apparent that

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the more specific patent claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 5,966,157. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to the artisan of ordinary skill in the art to employ the patented eye tracker with a laser surgical system.

Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 and 27-34 of copending Application No. 10/124,891. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent application "anticipate" the instant application claims. Accordingly, the instant application claims are not patentably distinct from the patent application claims. Here, the patent application claims require elements A, B, C, and D while instant application claim 1 only requires elements A, B, and C. Thus it is apparent that the more specific patent application claims encompass the instant application claims. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed September 12, 2005 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

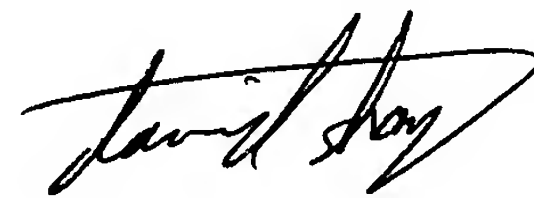
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ali Imam, can be reached on Monday, Tuesday, Wednesday, and Thursday at (571) 272-4740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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